

REMARKS

Claims 1, 3-8, 11-13, 15-19, 21-27, 30, and 32-34, as amended, are pending in this application. In this response, Applicants have amended claim 1 to further clarify the embodiments featured therein. As no new matter has been added by the amendments herein, Applicants respectfully request entry of these amendments at this time.

THE REJECTIONS UNDER 35 U.S.C. § 112

The Examiner rejected claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for the reasons set forth on pages 2-3 of the Office Action. The Examiner asserts that the specification does not provide adequate disclosure for inputting examination parameters into a computer operable to execute computer program instructions. Office Action at Page 3. However, a skilled artisan would readily understand that this step must be taken in order to provide the results of the examination on a website. As such, the fact that the results are reported on a website provides adequate support for inputting the examination parameters into a computer.

The Examiner also rejected claim 27 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Office Action at Page 3. In particular, the Examiner asserts that the step of providing an encoded test link lacks antecedent basis. *Id.* However, the Examiner appears to ignore the language of the claim. For example, claim 27 recites the method of claim 1 “further comprising” providing an encoded test link. As such, the step of providing an encoded test link is an additional step in the method, and therefore does not require antecedent basis.

In light of the foregoing, Applicants request reconsideration and withdrawal of the 35 U.S.C. § 112 rejections based thereon.

THE REJECTIONS UNDER 35 U.S.C. § 101

At pages 3-4 of the Office Action, the Examiner rejected claims 1, 3-8, 11-13, 15-19, 21-27, 30, and 32-34 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In support of this rejection, the Examiner appears to rely on case law that is no longer valid. In particular, the apparent reliance on the Federal Circuit case *In re Bilski* and its requirement that method claims must pass the “machine or transformation test” has been overturned by the Supreme Court. As the

Supreme Court clarified, the “machine or transformation” test used by the Federal Circuit is only one way to determine whether a method claim is directed to statutory subject matter. In light of the Supreme Court’s ruling, Applicants submit that the Examiner’s rejection is clearly improper.

Furthermore, the Examiner asserts that “the use of a machine is merely insignificantly related to the method steps.” Office Action at Pages 3–4. However, contrary to the Examiner’s assertion, the use of a computer is an integral part of the method. In fact, according to the method, the result of the examination is reported via a webpage, *i.e.*, by using a computer. *See, e.g.*, Written Description at Page 10, line 21–Page 11, line 8. In addition, claim 1 specifically recites the use of a computer operable to execute computer program instructions. As such, although no longer the rigid standard, the present method is tied to a particular machine and meets the requirements under 35 U.S.C. § 101. Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 101 rejection.

THE REJECTIONS UNDER 35 U.S.C. § 103

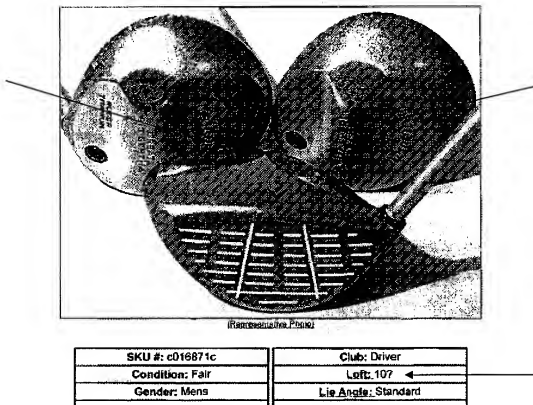
Claims 1, 3-8, 11-13, 15-19, 21-27, 30, and 32-34 were rejected under 35 U.S.C. § 103(a) as being obvious over various combinations of U.S. Publication No. 2002/0077956 to Solheim (“Solheim”), U.S. Patent No. 6,182,897 to Knowles (“Knowles”), a collection of archived webpages:

<http://web.archive.org/web/20011020005809/www.callawaygolfpreowned.com/trade-rules.html>;
<http://web.archive.org/web/20020601221544/www.callawaygolfpreowned.com/guarantee.html>;
<http://web.archive.org/web/20021203111831/www.callawaygolfpreowned.com/c016871c.html>; and
<http://web.archive.org/web/20020601224341/www.callawaygolfpreowned.com/condition.html>

(collectively “Callaway”), “Letters by Duchess of Windsor, Prince to Be Published; [Home Edition]”. Los Angeles Times (pre-1997 Fulltext). Los Angeles, Calif.: Apr 26, 1986, pg. 6) (hereinafter referred to as “Mehren”), U.S. Publication No. 2004/0054888 to Chester (“Chester”), “Scrutinizing the numbers” InfoWorld, San Mateo: Aug. 19, 2002, Vol. 24, Iss. 33, pg. 35 (“Harreld”), and U.S. Publication No. 2003/0171927 to Bernard (“Bernard”). None of the cited references and combinations disclose or suggest the present invention for at least the reasons that follow.

As a threshold matter, Applicants renew and incorporate the previous arguments against Solheim, Callaway, Mehren, Chester, Harreld, and Bernard. In sum, none of these references disclose or suggest a method for determining the authenticity, alteration status, *and* alteration condition of the golf equipment.

The Examiner asserts that Callaway discloses determining and reporting the alteration status and alteration condition. Office Action at Pages 6, 12, and 15. However, the Examiner's reliance on Callaway for disclosing alteration status and/or alteration condition is entirely unfounded. Office Action at Page 15. As shown below, Callaway merely provides a "representative photo" of the club head and does not provide a picture of the actual golf club that is for sale.



In addition, the "representative photo" shows both a 10° loft club head and an 11° loft club head (see arrows). However, the Callaway "meticulous inspection" was apparently unable to determine the actual loft angle of the club listed for sale. Rather, the loft angle is listed as "10?". See, e.g., Page 4. Thus, it is apparent that Callaway does not conduct any comparison of the actual club head with predetermined manufacturing specifications to determine an alteration status or alteration condition, as presently recited. In fact, the only mention of an inspection on Callaway's part is with

regard to the amount of wear and scratches on the surface of the club. *See, e.g.*, Page 4. Thus, Callaway (as well as the other cited references) lacks of any teaching or suggestion of determining an alteration status or alteration condition. As such, the Examiner cannot make a prima facie case for obviousness based on the limited disclosure of Callaway.

Finally, the Examiner's bare assertions that reporting the alteration condition, alteration status, and authenticity do not functionally alter or relate to the steps of the method ignores the actual steps of the method. Office Action at Page 7. For example, in order to report an alteration condition, the alteration condition must first be determined, as recited in the method. Thus, the alteration condition is a fundamental part of the method, and should not be casually (and without any support) dismissed as insignificant.

In light of the foregoing, none of the cited combinations disclose or suggest all of the steps of the presently recited method. As such, Applicants respectfully submit that the 35 U.S.C. § 103 rejection is overcome.

CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present remarks still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith extending the time period for response three months to and including April 25, 2010. No other fees are believed to be due at this time. Should any other fees be due, please charge them to Deposit Account No. 50-4545, Order No. 5221-043-US01.

Respectfully submitted,
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